

REMARKS

This is in response to the Office Action mailed on May 20, 2004. No claims are amended, canceled or added. Claims 1-23 and 25-38 remain pending in this application.

Telephone Interview

Applicant thanks Examiner Richard Camby for the courtesy extended in conducting a telephone interview with Applicant's representative, Marvin Beekman, on August 11, 2004. DeLorme et al. 6,321,158 was discussed. Applicant requested the Examiner to identify the portions of DeLorme et al. relied upon to show a PDA address book entry as used in the claims. The Examiner requested Applicant to point out structure in the PDA that allows the PDA to associate a PDA address book entry with the location to form a waypoint and integrate PDA address book functions with GPS capabilities, and further requested Applicant to argue why a combination of DeLorme et al. with any other reference that includes a PDA with an address book would not render the claim obvious under a possible §103 rejection. Applicant addresses these requests in this Office Action under the section entitled §102 Rejection of the Claims. Agreement was not reached as to the patentability of the currently rejected claims.

Drawings

In a previous response dated February 3, 2004, Applicant supplied corrected drawings that included a proposed amendment to Figures 12C and 12D on sheet 9/16. Applicant respectfully requests consideration and approval of these corrected drawings.

Information Disclosure Statement

Applicant submitted a Supplemental Information Disclosure Statement and a 1449 Form with the previous Amendment and Response on February 3, 2004. Applicant respectfully requests that an initialed copy of the 1449 Form be returned to Applicants' Representatives to indicate that the cited references have been considered by the Examiner.

§102 Rejection of the Claims

Claims 1-22 and 28-38 were rejected under 35 USC § 102(b) as being anticipated by DeLorme et al. (US 6,321,158). Applicant respectfully traverses.

The rejection stated:

The patent to DeLorme et al. discloses a PDA 15 as disclosed in Figure 1a3 with a GPS device and wire modem as well as CPU link The device down loads map data and gets points of interest and map data to generate a way point list as shown in Figure 3.

The rejection does not use the language of the claims. For example, the rejection does not use the term “PDA address book entry” as used in independent claims 1, 7, 14 and 28. Should the Examiner choose to maintain the rejection using the DeLorme et al. reference, or any other reference, Applicant respectfully requests the Examiner to clearly state the reasons for the rejection, and provide such information or references a may be useful in aiding Applicant to judge the propriety of continuing in the prosecution (See 37 CFR §1.104(a)(2)), and clearly designate the particular part relied upon and the pertinence thereof with respect to the language of the claims (See 37 CFR §1.104(c)(2)).

Applicant respectfully asserts that there is a distinction between a PDA address book entry and electronic map features (see, for example, page 10, line 23 to page 11, line 2, and page 14, line 25 to page 15, line 18 of the specification). An electronic map feature is a location that is associated with other information such as, for example, a name, address, telephone number, and the like, for the location (Page 10 line 26 to Page 11 line 1). Any identified location such as coordinates or an electronic map feature can provide a waypoint (Page 10 lines 23-26); and waypoints are used in electronic map or GPS applications as intended destinations, points of interest and to build routes. Waypoints are used in the present application to identify a location or electronic map feature that is associated with a PDA address book entry (Page 11 lines 1-2). Thus, the present subject matter allows address information to be shared between the address book and electronic map software applications (Page 12 lines 19-21) which prevents the duplication of data entry and data storage.

Applicant respectfully asserts that a distinction between PDA address books (and entries therein) from electronic map features / data is supported by DeLorme et al. DeLorme et al. uses the term “address book” along with the terms travel plans, map configurations, and point

information at column 43, lines 3-5 with respect to a discussion regarding synchronizing data between a desktop and PDA. DeLorme et al. uses the term “address book” along with the terms maps, text directions, route depictions, POI (point of interest) or point information, and digital photo data at column 72, lines 29-31 as examples of component databases with respect to a discussion regarding synchronizing selected component databases between the homebase (desktop) and portable(s) (PDA). Thus, a PDA address book entry and an address in an electronic map data are more than just a choice of words. Applicant is unable to find a showing or fair suggestion in DeLorme that the address book is associated or otherwise integrated with the maps, directions, routes, and POI or point information.

With respect to independent claim 1, Applicant is unable to find, among other things, in DeLorme et al. a method where a location is identified, a PDA address book entry is associated with the location to form a waypoint, and PDA address book functions are integrated with GPS capabilities, as recited in claim 1. The waypoint (for use in an electronic map / GPS application) is formed using the PDA address book entry. Claims 2-6 depend, either directly or indirectly, on independent claim 1, and are believed to be patentable at least for the reasons provided with respect to independent claim 1.

With respect to independent claim 7, Applicant is unable to find, among other things, in DeLorme et al. a method where a PDA address book entry is selected, a location is associated with the PDA address book entry to form a waypoint, and PDA address book functions are integrated with GPS capabilities, as recited in claim 7. The waypoint (for an electronic map / GPS application) is formed using the PDA address book entry. Claims 8-13 depend, either directly or indirectly, on independent claim 7, and are believed to be patentable at least for the reasons provided with respect to independent claim 7.

With respect to independent claim 14, Applicant is unable to find, among other things, in DeLorme et al. a computer-readable medium having computer-executable instructions adapted to associate a PDA address book entry with a location on an electronic map that is capable of being displayed on the PDA, as recited in claim 14. Claims 15-22 depend, either directly or indirectly, on independent claim 14, and are believed to be patentable at least for the reasons provided with respect to independent claim 14.

With respect to independent claim 28, Applicant is unable to find, among other things, in DeLorme et al., a PDA device with an integrated electronic map and address book, comprising a processor, a memory adapted to communicate to the processor and that includes address book data and electronic map data, where the device is adapted to associate a location that is capable of being displayed on the electronic map with a PDA address book entry to form a waypoint, as recited in the claim. Claims 29-38 depend, either directly or indirectly, on independent claim 28, and are believed to be patentable at least for the reasons provided with respect to independent claim 28.

Structure allowing PDA to associate a PDA address book entry with location to form a waypoint.

In the telephone interview dated August 11, 2004, the Examiner requested Applicant to point out structure in the PDA that allows the PDA to associate a PDA address book entry with the location to form a waypoint and integrate PDA address book functions with GPS capabilities.

The present subject matter integrates a PDA address book function with an electronic map that has GPS capabilities (Page 3 lines 19-20). Applicant respectfully asserts that this is illustrated and described throughout the application. For example, FIGS. 3-6 illustrate screen displays that integrate PDA functions with an electronic map that has GPS capabilities. In FIG. 3, an Address Link Screen for a PDA address book includes a waypoint indicator 320 which indicates that the address for an address book entry associated with a corresponding name has been saved as a waypoint for use in electronic map or GPS applications. FIG. 4 illustrates an address view screen in the PDA address book, and FIG. 5 illustrates an address edit screen in the PDA address book. Both the illustrated address view screen and address edit screen include a GOTO button to show a course from the present location of the PDA to the displayed address (an electronic map / GPS application), a WAYPOINT button to store an electronic GPS coordinate corresponding to the displayed address identified by the displayed name (an electronic map / GPS application), and a MAP button to generate a map screen such as illustrated in FIG. 6. FIG. 7 illustrates a PDA architecture that includes a PDA address book and further includes GPS applications; and FIG. 8 illustrates a representation of linked PDA address book data and electronic map data that permits sharing of address and other information between the address book and electronic map software applications such that a PDA address book entry can be

associated with a location to form a waypoint (for use in an electronic map / GPS application), and PDA address book functions are integrated with GPS capabilities. FIGS. 12A-12E illustrate a data structure (with latitude, longitude, and symbol) for use by a PDA to link PDA address book entries and locations/features (for use in an electronic map / GPS application). FIGS. 13-26 illustrate an embodiment where a custom field of a PDA address book entry is used to store the location, symbol and altitude for use by the PDA to link the PDA address book entry to a location to use by electronic map / GPS applications.

Combination of DeLorme et al. with a PDA with address book does not anticipate claims.

In the telephone interview dated August 11, 2004, the Examiner requested Applicant to argue why a combination of DeLorme et al. with any other reference that includes a PDA with an address book would not render the claim obvious under a possible §103 rejection. DeLorme et al. includes a PDA that uses an Integrated Routing/Mapping Information System (IRMIS) to link desktop personal computer cartographic applications to a PDA (Abstract). The PDA of DeLorme et al. includes an address book (column 43, lines 3-5 and column 72, lines 29-31); however, DeLorme et al. neither shows nor suggests that the PDA address book is integrated with the cartographic applications. Applicant notes that the claimed subject matter involves more than a PDA with separate GPS capabilities and an address book. If the DeLorme et al. reference was combined with another reference that has PDA with an address book, the combination would still lack a suggestion to associate a PDA address book entry with the location to form a waypoint and integrate PDA address book functions with GPS capabilities, as recited in claim 1 for example.

Reservation of right to swear behind DeLorme et al.

Applicant notes that U.S. 6,321,158 was filed on August 31, 1998 as Application No. 09/144836 and issued on November 20, 2001, less than one year before the present application was filed. DeLorme et al. claims priority to earlier applications as a continuation-in-part. However, no assertion has been made that the earlier applications support the rejection. Applicant maintains its right to swear behind any documents relied upon for a rejection under 35 U.S.C. §§102(a), 102(e), 103/102(a), and 103/102(e). Statements distinguishing the claimed

subject matter over the cited references are not to be interpreted as admissions that the documents are prior art.

Allowable Subject Matter

Claims 23 and 25-27 have been allowed.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6960 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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By their Representatives,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 17 day of August, 2004.

CANDIS BUENDING

Name

Charles Beekman
Signature